

Paper No. 9
RFC

THIS DISPOSITION IS NOT
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MAY 20, 1998

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Universal Services of America, Inc.

Serial No. 74/581,388

Edward A. Pennington of Morgan & Finnegan for Universal Services
of America, Inc.

Russ Herman, Trademark Examining Attorney, Law Office 102 (Myra
Kurzbard, Managing Attorney)

Before Cissel, Seeherman and Hohein, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 3, 1994, applicant filed an application to



register the mark shown below

on the Principal Register for what were subsequently identified
by amendment as "insurance underwriting services and insurance

brokerage services; financial management and financial planning services including tax return preparation and accounting services," in Class 36. The application was based on applicant's claim of use of the mark in connection with these services since October 8, 1992.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, as used in connection with the services set forth in the application, so resembles the mark "USA," which is registered¹ on the Principal Register under the provisions of Section 2(f) for "administration in the field of life insurance," that confusion is likely. The Examining Attorney also required applicant to disclaim the assertedly geographically descriptive term "USA" apart from the mark as shown.

Applicant submitted arguments in response to both the refusal and the requirement. Applicant argued that the letters do not have to be disclaimed because they are an acronym for applicant's trade name. Further, applicant argued that confusion is not likely because the services of applicant are different from those set forth in the registration, and the channels of trade through which the services move and customers to whom applicant's services are rendered are different as well.

¹ Reg. No. 1,691,934, issued to Universal Systems of America, Inc. on June 9, 1992; combined affidavit under Sections 8 and 15. The registration is based on a claim of use since October 10, 1983.

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The Examining Attorney was not persuaded on either issue, and made both the refusal and the requirement final with his second Office Action. Applicant timely filed a notice of appeal.

Both applicant and the Examining Attorney filed briefs. The Applicant did not request an oral hearing.

We note for the record that we have not considered the third-party registration information that the Examining Attorney submitted with his brief on appeal. These materials were not timely submitted. See Trademark Rule 2.142(d).

After careful consideration of the record and the arguments, we reverse the refusal to register, but we affirm the requirement for a disclaimer of the geographically descriptive letters "USA."

Turning first to the latter, we begin with the fact that Section 6 of the Act requires an applicant to disclaim an unregistrable component of a mark which is otherwise registrable. Section 2(e)(2) of the Act precludes registration of terms which are primarily geographically descriptive. The issue, then, in the case at hand, is whether "USA" is geographically descriptive as applied to the services specified in the application. Because it is, it must be disclaimed.

Applicant does not appear to dispute the well-settled test for geographic descriptiveness under the Lanham Act. That test provides that if the primary significance of the matter sought to be registered is geographical, i.e., if the term is the name of a place known generally to the public, and the public would make a services/place association, that is, believe that services of the kind set forth in the application originate in the named place, and the services of the applicant do in fact come from that

place, then the term is unregistrable under Section 2(e)(2) of the Act. Further, applicant does not appear to contest the fact that "USA" is a recognized acronym for "United States of America," nor does applicant dispute that "USA" is a place name known generally to the public, that insurance underwriting and brokerage services, financial management, financial planning and accounting services all are rendered in the USA, or that applicant is located in the United States and renders its services in the United States.

Applicant's argument appears to be that because the letters "USA" are also the initials of applicant's trade name, the primary significance of them to the relevant purchasing public is not the place name, but instead, that such people perceive the letters as applicant's service mark.

We see no basis for reaching this conclusion, however. "USA" is the well known acronym for the United States of America. We have no basis upon which to conclude that an appreciable number of people would recognize these letters as the initials for applicant's trade name. Applicant's argument is essentially that the geographic significance of "USA" has been replaced by source-indicating significance in the minds of applicant's customers. This amounts to a claim of distinctiveness under Section 2(f) of the Act, but applicant has neither amended the application to seek registration under Section 2(f), nor supported its argument with evidence. In the absence of such a

claim and evidence in support of it, we conclude that most consumers would recognize the letters as the abbreviation for the name of the country, rather than as the initials of Universal Services of America.

Not only is "USA" well known as an abbreviation for the name of this country, it is also well known that businesses in this country render insurance, financial and accounting services. In accordance with *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, (TTAB 1982), because the geographic significance of "USA" is its primary significance, and because the United States is neither obscure nor remote, it can be presumed that applicant's services come from this country, where applicant is located and does, in fact, render its services. Accordingly, we hold the letters "USA" to be primarily merely geographically descriptive within the meaning of Section 2(e)(2) of the Lanham Act, and as such, they must be disclaimed in accordance with Section 6 of the Act.

Although the requirement for a disclaimer of the letters "USA" is therefore affirmed, the refusal to register under Section 2(d) is not. Among the principles that have guided us to this conclusion is that in order for us to find that confusion is likely, not only must the marks be similar, but the goods or services with which they are used must be related in some way such that the use of similar marks in connection with them makes confusion likely. *In re Hal Leonard Publishing Corp.*, 15 USPQ2d

1574 (TTAB 1990). In this regard, the burden is on the Examining Attorney to support his factual contentions, such as that the services are related to each other, with evidence. See: In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

In the case at hand, although the similarities between applicant's mark and the mark in the cited registration are obvious, the Examining Attorney has not supported his refusal to register with any evidence that the services set forth in the application are related to those specified in the cited registration. Apparently he realized this by the time he attached the third-party registration evidence discussed above to his brief on appeal, but that evidence, as we also noted above, was untimely submitted and therefore has not been considered. Without it, we are simply without any basis for adopting the conclusion urged by the Examining Attorney with regard to the relationship between applicant's services of underwriting and brokering insurance and the service rendered by the registrant under the registered mark, namely administration in the field of life insurance. We cannot speculate based only upon the ways the services are identified in the application and the cited registration, respectively, that such services would be rendered by the same entity to the same group of customers.

Applicant, furthermore, makes a persuasive argument that these services are quite different. According to applicant,

insurance administration services entail providing third-party administrative services to insurance companies, and these services therefore involve a different clientele and different trade channels than applicant's services involve. Basically, applicant's argument is that registrant provides sophisticated purchasers, namely insurance companies, with policy level support, but that registrant does not sell or underwrite insurance, which is what applicant does for ordinary consumers.

In the absence of any evidence to the contrary, this makes sense to us. The burden was on the Examining Attorney to support the refusal with evidence establishing that these services are commercially related in such a way that the use of these similar marks in connection with them is likely to cause confusion. Because no such evidence is of record, the refusal must be reversed.

Decision: The refusal to register is reversed, but the requirement for a disclaimer of the geographically descriptive letters "USA" is affirmed. In view of Trademark Rule 2.142(g), however, if applicant submits the required disclaimer within thirty days of this ruling, the application will be passed to publication.

R. F. Cissel

E. J. Seeherman

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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